



UNITED STATES PATENT AND TRADEMARK OFFICE

R2003-114
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

FEB 10 2003

In re

:
:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to questions 11, 12 and 40 of the morning section and questions 13 and 21 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 9, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional one point for morning question 11 and an additional one point for morning question 12. Accordingly, petitioner has been granted an additional two points on the Examination. No credit has been awarded for morning question 40 and afternoon questions 13 and 21. Petitioner's arguments for these questions are addressed individually below.

Morning question 40 reads as follows:

40. Which of the following identifications of document(s) set forth in a return postcard that is stamped and returned by the USPTO will suffice for the postcard receipt to serve as *prima facie* evidence of the USPTO's receipt of the document(s) specified where the USPTO cannot locate the document(s)?

(A) For all pages of a complete new application - an identification stating: "the items listed in the transmittal letter that accompanied the application", where the registered practitioner can furnish a copy of the transmittal letter, and where the transmittal letter contained a list of the component parts of a complete application.

(B) For all pages of a complete new application - an identification stating: "a complete application".

(C) For all pages of a complete new application containing the following components - an identification stating: "specification (including written description, claims and abstract), drawings, declaration".

(D) For two sheets of drawings - an identification stating "2 sheets of drawings".

(E) All of the above.

40. The model answer: (D) is the most correct answer. (A) and (B) are incorrect because, pursuant to MPEP § 503, the return postcard itself must specifically itemize the component parts of the new application. (C) is incorrect because, pursuant to MPEP § 503, the number of pages of each of the component parts of an application must be specified to obtain *prima facie* evidence of what was filed. In light of (A), (B), and (C) being incorrect, (E) is also incorrect.

Petitioner argues that answer (C) is correct. Petitioner contends that there is no requirement in MPEP § 503 to list the number of claims, pages of the specification, or sheets of drawings. Petitioner further contends that answer (C) "is at least correct in connection with an application containing a single page specification, a single claim page, an Abstract on a separate page, and a single drawing page."

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that each item is itemized in answer (C), MPEP § 503 states that the identifying data on the postcard should include "(C) number of pages of specification, claims (for nonprovisional applications), and sheets of drawings." (Emphasis added.) Answer (C) does not indicate by number how many pages of specification and how many sheets of drawings have been submitted. Furthermore, petitioner concedes that MPEP § 503 suggests that the number of the pages of specification should be listed. The directions to the examination state that "[t]he most correct answer is the policy, practice, and procedure which must, shall or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice, the

Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question” (Emphasis added.) Petitioner argues that answer C “is at least correct in connection with an application containing a single page specification, a single claim page an Abstract on a separate page, and a single drawing page.” The directions of the examination state “[d]o not assume any additional facts not presented in the question.” Question 40 does not state that a single page specification, a single claim page, an Abstract on a separate page and a single drawing page were being submitted to the Office with the postcard, rather the questions says “document(s).” Answer (D) is the most correct answer since it is the practice that should be followed in accordance with MPEP § 503. Accordingly, model answer (D) is correct and petitioner’s answer (C) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 13 reads as follows:

13. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

(A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.

(B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.

(C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR 1.8, of the preliminary amendment.

(D) All of the above.

(E) (A) and (B).

13. The model answer: (E) is the correct answer. 37 C.F.R. § 1.115(b)(1). As stated in 65 FR at 54636, middle and right columns, “Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office...” Thus, choices (C) and (D) are incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that 37 C.F.R. § 1.8 specifically provides for a certificate of mailing on all correspondence sent to the office except for those specifically excluded by § 1.8. Petitioner further contends that 37 C.F.R.

§ 115(b)(1) does not explicitly preclude the office from considering date of mailing under 37 C.F.R. §1.8

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that 37 C.F.R. § 1.8 specifically provides for a certificate of mailing on all correspondence, 37 C.F.R. § 1.8(a) states "Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed." (Emphasis added.) A preliminary amendment is neither required to be filed in the Patent and Trademark Office, nor is it due within a set period of time, so 37 C.F.R. § 1.8 does not apply. Furthermore, 37 C.F.R. § 1.115(b)(1)(i) states that a factor considered in disapproving a preliminary amendment includes the state of preparation of a first Office action as of the date of receipt (§ 1.6), and while § 1.115 does not explicitly preclude the Office from considering the date of mailing under 37 C.F.R. § 1.8, this is irrelevant since § 1.8 does not apply to preliminary amendments. Accordingly, model answer E is correct and petitioner's answer D is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 21 reads as follows:

21. As a new member of a law firm, you are assigned to continue the prosecution of a patent application that was prosecuted by Stewart, who recently joined another law firm. After reviewing the file, you note that Stewart's reply to a first Office included two amendments: Amendment #1 introduced a change to the specification which did not affect the claims; Amendment #2 introduced a change to the specification, which change was also introduced to all of the claims currently in the application. You also note that the examiner in a current Office action has taken the position that both amendments constituted new matter, required cancellation of the new matter, and rejected all the claims on the ground that they recited elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph. For the purpose of reviewing the examiner's requirement, which of the following statements accords with proper USPTO practice and procedure?

- (A) Both Amendment #1 and Amendment #2 give rise to appealable questions.
- (B) Review of the examiner's requirement for cancellation of both Amendment #1 and Amendment #2 is by way of petition.
- (C) Review of the examiner's requirement for cancellation of Amendment #1 is by way of petition, and review of the examiner's requirement for cancellation of Amendment #2 is by way of appeal.

(D) Review of the examiner's requirement for cancellation of Amendment #1 is by way of appeal, and review of the examiner's requirement for cancellation of Amendment #2 is by way of petition.

(E) Both Amendment #1 and Amendment #2 give rise to questions which may be reviewed either by petition or on appeal.

21. The model answer: (C) is the correct answer. MPEP § 608.04(c) includes the following recitation: Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one. See, also, MPEP § 706.03(o), which includes the following recitation: In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph.

Petitioner argues that answer (A) is correct. Petitioner contends that rejecting a claim based on new matter added to the specification is an appealable issue, and since the rejections under 35 U.S.C. § 112 represent an appealable matter, both amendments to the specification and the claims would constitute appealable actions by the Examiner. Petitioner further argues that MPEP § 608.04(c), as relied on by the model answer, disagrees with the Code of Federal Regulations.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that both amendments to the specification and the claims would constitute an appealable matter, this is not the case. The question states that the claims were "rejected on the ground that they recited elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph," not that they were rejected based on new matter added to the specification. 37 C.F.R. 1.191(a) states that every applicant for a patent "whose claims has been twice or finally (§1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply." The Board of Patent Appeals and Interferences reviews rejections of the claims made by the examiner. The examiner cannot make a rejection of the specification, and the first amendment did not add new claims to the application. 37 C.F.R. § 1.181(a) states that a petition may be filed from any action "which is not subject to an appeal to the Board of Patent Appeals and Interferences or to the court." Since it is not within the jurisdiction of the Board of Patent Appeals and Interferences (as defined in 37 C.F.R. § 1.191) to render decisions on the existence of new matter in the specification, the issue must be taken up with the Commissioner by way of a petition. MPEP § 608.04(c) correctly explains proper procedure in accordance with the §§ 1.181 and 1.191. Accordingly, model answer (C) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, two points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above the printed name and title of the official.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy



UNITED STATES PATENT AND TRADEMARK OFFICE

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APR 3 2003

In re

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: DECISION ON
: PETITION FOR
: REVIEW OF DIRECTOR'S
: DECISION
: UNDER 37 CFR 10.2(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for review of the Director's decision mailed on February 10, 2003 under 37 CFR 10.2(c) and requests reconsideration for the answer to question 13 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On July 9, 2002, petitioner requested regrading, arguing that the model answers were

incorrect. On February 10, 2003, the Office mailed a decision on the petition for regrade denying the petition to the extent that the petitioner sought a passing grade on the Registration Examination. Petitioner was given credit for questions 11 and 12 of the morning session, and accordingly, petitioner's score was increased to 69. On March 7, 2003, petitioner filed a petition for review of Director's decision under 37 CFR 10.2(c).

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

OPINION

Under 37 CFR 10.2(c), any petition for review of Director's decision shall contain (1) a statement of the facts involved and the points to be reviewed and (2) the action requested. Briefs or memoranda, if any, in support of the petition shall accompany or be embodied therein. The petition will be decided on the basis of the record made before the Director and no new evidence will be considered by the Director in deciding the petition. For a petition for regrade, pursuant to 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no additional point for afternoon question 13. Accordingly, petitioner has been granted no additional points as a result of the review of

the Director's decision. No credit has been awarded for afternoon question 13.

Petitioner's arguments for these questions are addressed individually below.

Afternoon question 13 reads as follows:

13. Which of the following is or are a factor that will be considered in disapproving a preliminary amendment in an application filed November 10, 2000?

(A) The nature of any changes to the claims or specification that would result from entry of the preliminary amendment.

(B) The state of preparation of a first Office action as of the date of receipt of the preliminary amendment by the Office.

(C) The state of preparation of a first Office action as of the certificate of mailing date under 37 CFR 1.8, of the preliminary amendment.

(D) All of the above.

(E) (A) and (B).

13. The model answer: (E) is the correct answer. 37 C.F.R. § 1.115(b)(1). As stated in 65 FR at 54636, middle and right columns, "Factors that will be considered in disapproving a preliminary amendment include: the state of preparation of a first Office action as of the date of receipt (§1.6, which does not include § 1.8 certificate of mailing dates) of the preliminary amendment by the Office..." Thus, choices (C) and (D) are incorrect.

Petitioner argues that answer (D) is correct. Petitioner contends that since there is one or more situations wherein a preliminary amendment is required to be submitted within a set period of time, the certificate of mailing practice under 37 CFR 1.8 applies and thus (D) is the best answer. Petitioner argues that under 37 CFR 1.78(a)(2)(ii), the specification must be amended to properly claim priority within four months of the filing date of the application to any earlier filed application for which a benefit is sought. Petitioner argues that since 37 CFR 1.8 does not explicitly preclude preliminary amendments and they may be used to grant entry of a preliminary amendment for a priority claim under 37 CFR 1.78(a)(2), therefore the reasoning set forth in the prior regrade decision is incorrect. Petitioner argues that while she has only presented one example wherein a preliminary amendment may rely on a certificate of mailing under 37 CFR 1.8, it is possible that there are other scenarios where a certificate of mailing may apply. Therefore, petitioner contends that her answer (D) is correct and the best answer.

Petitioner's arguments have been fully considered but are not persuasive. Preliminary amendments are considered by the Office based on the date of receipt (37 CFR 1.6) and not the certificate of mailing date (37 CFR 1.8). 37 CFR 1.115(a) defines a preliminary amendment as an amendment that is **received** in the Office (37 CFR 1.6) on or before the mail date of the first Office action under 37 CFR 1.104. MPEP 714.01(e) further provides that "[i]f the **date of receipt (37 CFR 1.6)** of the amendment is later than the mail date of the first Office action and is not responsive to the first Office action, the Office will not mail a new Office action, but simply advise the applicant that the amendment is nonresponsive to the first Office action and that a responsive reply must be timely filed to avoid abandonment." (Emphasis added.) Accordingly, an amendment that has a date of receipt after the mail date of the first Office action will not be considered as a preliminary amendment, even if the certificate of mailing date is earlier than the mail date of the first Office action. Such amendment would be treated as a nonresponsive amendment to the first Office action. Furthermore, 37 CFR 1.115(b)(1) specifically provides that one of the factors that will be considered in disapproving a preliminary amendment is the state of preparation of a first Office action as of the date of receipt (37 CFR 1.6), which is not the certificate of mailing date under 37 CFR 1.8. Therefore, answer (C) and answer (D) are incorrect because the state of preparation of a first Office action as of the certificate of mailing date under 37 CFR 1.8 of the preliminary amendment is not one of the factors that will be considered in disapproving a preliminary amendment.

Petitioner argued that there are one or more examples where 37 CFR 1.8 applies to preliminary amendments. Petitioner, however, presented only one example where the petitioner assumed that the preliminary amendment is an amendment to the specification to add a specific reference to a prior application for a benefit claim under 37 CFR 1.78(a)(2). Petitioner's argument is based on facts that are not given in the question. Petitioner is reminded that the instructions to the examination state that petitioner should not assume any additional facts not presented in the questions. Thus, the petitioner should not presume that the preliminary amendment is an amendment to the specification for adding a benefit claim when answering the question.

The petitioner should also note that the time period requirements in 37 CFR 1.78(a)(2)(ii) do not apply to this question. The question clearly states that the preliminary amendment is filed in an application filed on November 10, 2000. The time period requirements in 37 CFR 1.78(a)(2)(ii) do not apply to applications filed before November 29, 2000. See 37 CFR 1.78(a)(2)(ii)(B) and Requirements for Claiming the Benefit of Prior-Filed Applications under Eighteen-Month Publication of Patent Applications, 66 FR 67087 (Dec. 28, 2001), 1254 Off. Gaz. Pat. Office Notices 121 (Jan. 22, 2002) (final rule). Accordingly, the certificate of mailing under 37 CFR 1.8 would not be applicable in the petitioner's example because the preliminary amendment for adding the benefit claim to the specification would not be required to be filed in the Office within the time period set forth in 37 CFR 1.78(a)(2)(ii).

Under 37 CFR 1.8, except in certain situations, correspondence required to be filed in the Office within a set period of time will be considered as being timely filed if the procedure described in the rule is followed. 37 CFR 1.8, further, states that the actual date of receipt will be used for all other purposes. Even if the time period under 37 CFR 1.78(a)(2) applied to the preliminary amendment in the petitioner's example, the preliminary amendment would be considered timely filed within the time period set forth in 37 CFR 1.78(a)(2)(ii) using the certificate of mailing date, but the certificate of mailing date would not be used for the purpose of disapproving the preliminary amendment under 37 CFR 1.115(b).

Accordingly, model answer (E) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

In the decision for the petition for regrade, 2 points were added to petitioner's score on the Examination. Therefore, petitioner's score is 69. No points have been added as a result of the petition for review of the Director's decision. Accordingly, petitioner's score is still 69. This score is insufficient to pass the Examination.

Upon review of the Director's decision and reconsideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy